

JAN 31 2000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jeffery Skolnick *et al.*

Art Unit : 1618

Serial No. : 09/322,067

Examiner : T. McCarthy III.

Filed : May 27, 1999

Title : **METHODS AND SYSTEMS FOR PREDICTING PROTEIN FUNCTION**

Assistant Commissioner for Patents  
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Herein Applicants respond to the Restriction Requirement dated November 8, 1999.  
Enclosed please find a petition for a two month extension so as to make this response timely.

REMARKS

A four-way restriction has been advanced regarding pending claims 1-52. In particular, Group I is said to comprise claims 1-19; Group II, claims 20-22; Group III, claims 23-42; and Group IV, claims 43-52. Applicants elect to prosecute claims 1-19 (Group I) in this application, although they traverse the restriction requirement as it relates to Groups II and IV, and they respectfully request reconsideration in view of the following remarks.

Two criteria must be satisfied for a proper restriction requirement: the inventions must be independent or distinct; and there must be a serious burden on the examiner. *See* MPEP § 803. A serious burden can be demonstrated by showing that the inventions are separately classified, have attained a separate status in the art, or would require different fields of search. *Id.* Here, the Group I claims are drawn to functional site descriptors. Functional site descriptors comprise a set of geometric constraints for one or more atoms in each of two or more amino acid residues comprising a functional site of a protein. The claims of Group II, claims 20-22, are drawn to libraries comprising at least one functional site descriptor. No showing has been made that

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functional site descriptors, and libraries of such descriptors, would be separately classified, have a different status in the art, or require different fields of search. In short, there would be no serious burden on the Examiner to examine the claims of Groups I and II in this application. Accordingly, Applicants request that the restriction requirement with regard to claims 20-22 be withdrawn, and that Group II claims be examined in this application.

As for Groups I and IV, Applicants do not dispute that the subject matter of Group IV concerns processes for making the functional site descriptors according to the claims of Group I. However, that, in and of itself, is not a sufficient basis for advancing a restriction requirement, as not serious burden has been demonstrated. As a result, both criteria for a proper restriction requirement as between the subject matter of Groups I and IV have not been satisfied. The restriction requirement as between Groups I and IV should therefore be withdrawn.

#### CONCLUSION

Applicants have elected to prosecute the subject matter of Group I (currently claims 1-19) in this application. They have also traversed the restriction requirement with regard to Groups II and IV. As a result, Applicants respectfully request that the Examiner examine the inventions of Group I, II, and IV in this application. Applicants will cancel claims drawn to non-elected subject matter at a future date, and they reserve the right to pursue claims drawn to this or non-elected or not yet claimed subject matter in one or more related applications.

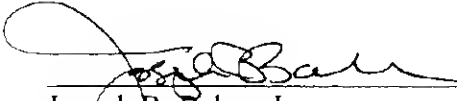
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Respectfully submitted,

Date: 1/24/2000

  
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